

### **REMARKS**

Claims 1-19 and 26-34 were previously pending. No claims have been added or canceled. Reconsideration of presently pending claims 1-19 and 26-34 is respectfully requested in light of the above amendments and the following remarks.

#### **Double Patenting**

**Claims 1-19** stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 101-103, 106-110, 112-113 of copending U.S. Patent Application Ser. No. 09/924,298. Applicants again acknowledge this provisional rejection and will address any double patenting issues if and when a double patenting problem comes to fruition.

#### **§ 102 Rejections**

**Claims 1, 2, 17-19, 26-29, 32, and 33** stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,370,697 to Baumgartner ("Baumgartner").

The PTO provides in MPEP § 2131 that

*"[t]o anticipate a claim, the reference must teach every element of the claim...."*

Therefore, to sustain the rejection of these claims Baumgartner must teach all of the claimed elements. However, Baumgartner fails to disclose all of the claimed elements of independent claims 1, 2, and 26 and, therefore, dependent claims 17-19, 27-29, 32, and 33.

With respect to claim 1, Baumgartner at least fails to teach "a first component having an articular surface for articulated movement with the shell" and "wherein the body member is adapted to articulate with respect to the shell such that one or more surfaces of the shell come into contact with the articular surface of the first component during articulation." Rather, in Baumgartner "the insert part 5 is **fixed** to the supports 2, 3 by a snap fastening 28," or "the insert part 5 may be inserted ventrally into the parallel profile guides 21 and be **securely and rigidly**

**held in its final position.**” Col. 2, Lines 61-62; Col. 3, Lines 8-11. As described in Baumgartner, the insert part 5 is not adapted to articulate with respect to a shell as required by claim 1. Rather, the insert part 5 of Baumgartner is to be securely and rigidly fixed to the supports 2, 3. Thus, for at least these reasons Baumgartner fails to anticipate independent claim 1 and its dependent claims 17-19.

Similarly, independent claim 2 recites “a first component having an articular surface for articulated movement with the shell,” “the third component having an articular surface for articulated movement with the shell,” and “wherein the body member is adapted to articulate with respect to the shell such that one or more surfaces of the shell come into contact with the articular surfaces of the first and third components during articulation.” Thus, for at least the same reasons Baumgartner fails to anticipate independent claim 2.

With respect to independent claim 26, Baumgartner at least fails to teach, “a first portion configured to articulate with a first surface of the shell structure” and “a second portion configured to articulate with a second surface of the shell structure.” As shown above, the insert part 5 and, in particular, the cover plates 25, 26 are not adapted to articulate with a surface of a shell structure as required by claim 26. Rather, the insert part 5 and its cover plates 25, 26 are adapted to be securely and rigidly fixed to the supports 2, 3. Thus, Baumgartner fails to teach first and second portions configured to articulate with first and second surfaces of the shell structure as recited by claim 26. Therefore, for at least these reasons Baumgartner fails to anticipate independent claim 26 and its dependent claims 27-33.

Therefore, the §102 rejections of claims 1, 2, 17-19, 26-29, 32, and 33 are not supported by Baumgartner. Thus, Applicants respectfully request that the Examiner withdraw these §102(b) rejections.

Though no rejections in the current Office Action were based on U.S. Patent 6,419,706 to Graf (“Graf”), the Examiner made reference to Graf. In an effort to expedite prosecution, Applicants would point out that the core 404 of the prosthesis 402 (Figs. 18-22) is not configured for articulated movement with respect to a shell. Rather, the core 404 is attached to the casing via an adhesive, but the casing is shaped to allow sufficient room for the core to expand during

compression of the prosthesis. In particular, Graf describes the prosthesis 402 as follows:

“This prosthesis [402] comprises a core 404 which is made of a biocompatible elastic material and whose outer surface is partially covered by means of a casing made up of two elements 406A and 406B. These elements [406A and 406B], made of a biocompatible rigid material, are attached to the core 404 by means of a silicone adhesive, for example.” Col. 7, Lines 45-51 (emphasis added).

Thus, for at least these reasons Graf does not anticipate independent claims 1, 2, and 26 and cannot properly support a rejection.

### **§103 Rejections**

**Claims 3-7 and 10-16** stand rejected under 35 U.S.C. §103 as being unpatentable over Baumgartner. However, as shown above Baumgartner fails to teach all of the elements of independent claim 1, which claims 3-7 and 10-16 depend from and further limit. Thus, the §103 rejection of claims 3-7 and 10-16 over Baumgartner cannot be supported. Therefore, Applicants respectfully request that the Examiner withdraw these §103 rejections.

**Claims 30, 31, and 34** stand rejected under 35 U.S.C. §103 as being unpatentable over Baumgartner in view of U.S. Patent No. 5,401,269 to Buttner-Janz et al. (“Buttner-Janz”). The Office Action notes that “Baumgartner discloses all the limitations, except for an opening adapted to receive a first projection and a second projection of the shell.” However, as shown above Baumgartner at least fails to teach all of the elements of independent claim 26, which claims 30 and 31 depend from and further limit. Further, the Office Action asserts:

“Buttner-Janz et al evidence the use of a core having an opening adapted to receive a projection of the shell to limit the rotational movement and the bending movement of the prosthesis. Therefore, given the teaching of Buttner-Janz et al, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the device of Baumgartner, as taught by Buttner-Janz et al to limit the rotational movement and the bending movement of the prosthesis.”

However, Baumgartner and Buttner-Janz are not properly combinable as suggested. In

particular, having the insert 5 of Baumgartner engage a projection of a shell as suggested would destroy at least one of the intended functions of the Baumgartner device. One of the intended functions of the Baumgartner device is described as follows:

“The exchangeable insert part also enables a simple later revision if the anatomical characteristics change over the years. A new insert part with the appropriate adaptations can be inserted into the supports, without the supports, which have fused with the adjacent vertebrae, becoming loose or having to be removed.” Col. 2, Lines 25-31.

In that regard, Baumgartner notes that the insert part “can be inserted from outside into the final position and can be attached there, making it possible to select and adapt this insert part precisely to the given situation.” Col. 1, Lines 44-48. The insert part “can be inserted parallel between the vertebrae 32, 33 from the lateral direction” or the insert part can “be inserted ventrally into the parallel profile guides 21.” Col. 2, Lines 56-57; Col. 3, Lines 9-10. As shown in Figs. 1a and 2a below, the insert part 5 slides laterally or ventrally into channels of the upper and lower supports 2, 3. If the insert part 5 and the upper and lower supports 2, 3 of Baumgartner were modified to include a rib and groove as described in Buttner-Janz, then the insert part would not be able to slide into the channels of the upper and lower supports, thereby defeating at least one of the intended purposes of the Baumgartner device. Further, the insert part 5 of Baumgartner is to be rigidly fixed to the supports 2, 3, (See, Col. 2, Lines 61-62; Col. 3, Lines 8-11) whereas the core of Buttner-Janz is configured to articulate with respect to the plates (See, Col. 1, Lines 4-9). Thus, for at least these reasons the §103 rejection of claims 30 and 31 over Baumgartner and Buttner-Janz cannot be supported.

Fig. 1a

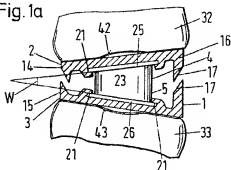
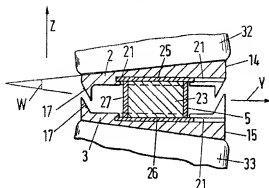


Fig. 2a



With respect to independent claim 34, the Office Action notes that “Baumgartner discloses all the limitations, except for an opening adapted to receive a first projection and a second projection of the shell.” However, as shown above with respect Baumgartner fails to teach “a first portion configured to articulate with the first half of the shell structure” and “a second portion configured to articulate with the second half of the shell structure.” Thus, Baumgartner does not disclose all of the limitations of claim 34 as asserted. Further, claim 34 recites, “the second portion ... having at least one projection adapted to slidably engage with the at least one recess of the first portion.” The Office Action simply does not address this limitation. Claim 34 does not recite an opening for receiving a projection of a shell similar to claims 30 and 31 as implied by the Office Action. Rather, claim 34 requires that a second portion of the body member have at least one projection to slidably engage the at least one recess of the first portion of the body member. Baumgartner and Buttner-Janz alone and/or in combination simply do not teach such a limitation. Thus, for at least these reasons the §103 rejection of claim 34 over Baumgartner and Buttner-Janz cannot be supported.

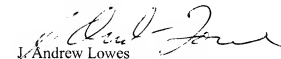
Therefore, Applicants respectfully request that the Examiner withdraw the §103 rejections of claims 30, 31, and 34.

**CONCLUSION**

It is clear from the foregoing that independent claims 1, 2, 26, and 34 are in condition for allowance. Dependent claims 3-19 and 27-33 depend from and further limit the independent claims and, therefore, are allowable as well.

It is believed that all matters set forth in the Final Office Action have been addressed, and that claims 1-19 and 26-34 are in condition for allowance. Favorable consideration and an early indication of allowance of the claims are respectfully requested. Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

  
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